

Remarks

Applicants submit the following remarks in support of the patentability of the presently claimed invention over the disclosures of the references relied upon by the Examiner in rejecting the claims. Further and favorable reconsideration is respectfully requested in view of these remarks.

Initially, claim 11 has been cancelled, since a divisional application for the subject matter of this claim was filed June 17, 2004.

Substance of Interview

Applicants express their appreciation for the courtesy of a personal interview granted to their attorney by Examiner Madsen and Mr. Cano, on January 12, 2004.

During the interview, Applicants' attorney noted that claim 11 will be cancelled since a divisional application for this claim has been filed. Claim 11 has now been cancelled.

Applicants' attorney also raised the possibility of rejoining claim 13, since it is directed to a cosmetic containing the composition of claim 1, now being examined. The Examiner indicated that he will consider the possibility of rejoining claim 13 if claim 1 is found to be patentable.

The interview focused on the Examiner's position as set forth in item 6 on pages 2-3 of the Office Action, wherein the Examiner takes the position that the facts presented in the Declaration Under 37 CFR 1.132 filed June 7, 2004 (Rule 132 Declaration) are not germane to the rejection at issue, because the experiments therein are directed to the primary reference and not the combination of references, which according to the Examiner, is not relevant to the issue of non-obviousness of the claimed subject matter and provides no objective evidence thereof, referring to MPEP 716.

Contrary to the Examiner's position, Applicants' attorney took the position that it is only necessary for the Rule 132 Declaration to compare the presently claimed invention with the closest single prior art reference, rather than a combination of references, as indicated in MPEP 716.02(e). As noted in the Interview Summary form, the Examiner will reconsider Applicants' position in this regard.

Also during the interview, the Examiner expressed agreement with Applicants that the Rule 132 Declaration does show superior results for the presently claimed invention as compared to the applied prior art references.

Discussion of Rejections

The rejection of claims 1-4, 6, 8 and 10 under 35 U.S.C. §103(a) as being unpatentable over Shiseido (JP 06040845 A) in view of Hattori et al. (JP 406157238 A), as well as the rejection of claims 1, 6, 8, 10 and 12 under 35 U.S.C. §103(a) as being unpatentable over Morimoto et al. (JP 410056969 A) in view of Morimoto et al. (JP 10066516) are respectfully traversed.

Applicants continue to rely on their patentability arguments of record, as well as the Rule 132 Declaration, which were filed June 7, 2004, against both these rejections. The essence of these arguments is that the Rule 132 Declaration establishes that there is an unexpected remarkable improvement of storage stability of perfume and coloring agent achieved by a combination of trehalose and water-soluble hemicellulose in accordance with the present invention, as compared to the storage stability which is achieved by a combination of trehalose and a water-soluble high polymer, and by a combination of water-soluble hemicellulose and a water-soluble high polymer in accordance with each of the applied references, as shown in the Rule 132 Declaration.

Although the Examiner agrees that the Rule 132 Declaration shows superior results for the present invention as compared to each of the applied references when taken individually, the Examiner's position in item 6 of the Office Action is that it is necessary to compare the present invention with "the combination of references." Applicants respectfully submit that this is not correct, as will be discussed below.

MPEP 716, referred to by the Examiner, provides some form paragraphs in responding to insufficient Rule 132 Declarations, such as "facts presented are not germane to the rejection at issue", "provides no objective evidence thereof", "amount to an affirmation that the claimed subject matter functions as it was intended to function", etc. However, there is nothing in MPEP 716 itself which establishes, in the case of a rejection based on a combination of references, that the Rule 132 Declaration must compare the claimed invention with a combination of the references.

However, this issue is specifically addressed in MPEP 716.02(e), as follows:

An affidavit or declaration under 37 CFR 1.132 must compare the claimed subject matter with the closest prior art to be effective to rebut a *prima facie* case of obviousness. . . . “A comparison of the *claimed* invention with the disclosure of each cited reference to determine the number of claim limitations in common with each reference, bearing in mind the relative importance of particular limitations, will usually yield the closest single prior art reference.”

. . .

>III. <THE CLAIMED INVENTION MAY BE COMPARED WITH THE CLOSEST SUBJECT MATTER THAT EXISTS IN THE PRIOR ART

Although evidence of unexpected results must compare the claimed invention with the closest prior art, applicant is not required to compare the claimed invention with subject matter that does not exist in the prior art. *In re Geiger*, 815 F.2d 686, 689, 2 USPQ2d 1276, 1279 (Fed. Cir. 1987) (Newman, J., concurring) (Evidence rebutted *prima facie* case by comparing claimed invention with the most relevant prior art. Note that the majority held the Office failed to establish a *prima facie* case of obviousness.); *In re Chapman*, 357 F.2d 418, 148 USPQ 711 (CCPA 1966) (Requiring applicant to compare claimed invention with polymer suggested by the combination of references relied upon in the rejection of the claimed invention under 35 U.S.C. 103 “would be requiring comparison of the results of the invention with the results of the invention.” 357 F.2d at 422, 148 USPQ at 714.). (Emphasis added by underlining)

As indicated under item III in this quote, an applicant is not required to compare the claimed invention with subject matter that does not exist in the prior art. In the present factual case, the claimed subject matter as set forth in the rejected claims clearly does not exist in any of the applied references, since if it did exist, the rejection would be for anticipation under 35 U.S.C. §102. The claimed invention is directed to the use of a combination of trehalose and water-soluble hemicellulose. Shisheido discloses the use of trehalose; Hattori et al. disclose the use of water-soluble hemicellulose; Morimoto et al. ‘969 discloses the use of water-soluble hemicellulose; and Morimoto et al. ‘516 discloses the use of trehalose; but none of these references discloses the use of a combination of trehalose and water-soluble hemicellulose. The use of this combination as in the present invention “does not exist in the prior art” references applied by the Examiner. Therefore, contrary to the

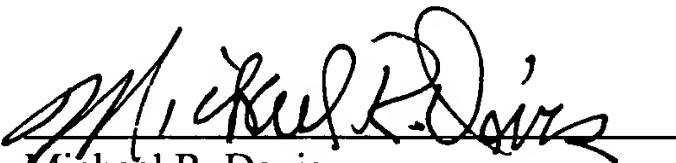
Examiner's position as set forth in item 6 of the Office Action, according to MPEP 716.02(e) Applicants are not required to compare the claimed invention with the use of this combination of trehalose and water-soluble hemicellulose.

Applicants have demonstrated, as shown in the Rule 132 Declaration, that the presently claimed invention gives superior results compared to each of the applied references. The Examiner has agreed with this. There is no suggestion in any of the references which would lead one of ordinary skill in the art to expect that these superior results could be achieved by using a combination of trehalose and water-soluble hemicellulose as in the present invention. Accordingly, Applicants respectfully submit that any presumption of obviousness which may have been established based on the references has been overcome.

Therefore, in view of the foregoing remarks, it is submitted that each of the grounds of rejection set forth by the Examiner has been overcome, and that the application is in condition for allowance. Such allowance is solicited.

Respectfully submitted,

Takayuki WATANABE et al.

By: 
Michael R. Davis
Registration No. 25,134
Attorney for Applicants

MRD/pth
Washington, D.C. 20006-1021
Telephone (202) 721-8200
Facsimile (202) 721-8250
February 7, 2005